

The opinion in support of the decision being entered today
(1) was **not** written for publication in a law journal and
(2) is **not** binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY CHESS

Appeal No. 1997-0835
Application No. 08/308,076

ON BRIEF

Before JOHN D. SMITH, GARRIS and OWENS, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 1-20.

Representative claims 1, 8 and 14 are reproduced below:

1. A business form comprising:

a first , paper, sheet having a first face with indicia thereon, and a second face with a first press-ure sensitive adhesive system;

a second sheet substantially the same size and shape as said first sheet, and having a first face,

and a second face with a second pressure sensitive adhesive system;

said first and second adhesive systems being constructed so that said second faces of said first and second sheets when placed in face-to-face engagement with each other will separate from each other, providing adhesive on each of said second faces after they separate;

said second faces in aligned engagement with each other; and wherein said second sheet is water-impermeable plastic, and said second sheet and said second adhesive system are substantially transparent, and said second adhesive system will adhere to said first face of said first sheet if applied thereto, to protect it.

8. A business form comprising:

a first , unsegmented paper, sheet having a first face with indicia thereon, and a second face with a first pressure sensitive adhesive system;

a second, paper, sheet substantially the same size and shape as said first sheet, and having a first face and a second face with a second pressure sensitive adhesive system;

said first and second adhesive systems being constructed so that said second faces of said first and second sheets when placed in face-to-face engagement with each other will separate from each other, providing adhesive on each of said second faces after they separate;

said second faces in aligned engagement with each other; and wherein said second sheet first face has indicia thereon, and further includes a plurality of lines of weakness separating said second sheet into a plurality of individual labels,

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each label with indicia thereon.

14. A multi-ply business form comprising:

a first, paper, sheet having a first face with indicia thereon, and a second face with a first pressure sensitive adhesive system, and wherein said first sheet first face has a carbonless coating thereon;

a second sheet substantially the same size and shape as said first sheet, and having a first face, and a second face with a second pressure sensitive adhesive system;

said first and second adhesive systems being constructed so that said second faces of said first and second sheets when placed in face-to-face engagement with each other will separate from each other, providing adhesive on each of said second faces after they separate;

said second faces in aligned engagement with each other; and a third sheet having a first face with indicia thereon, and a second face with a carbonless coating thereon cooperating with said first sheet carbonless coating and overlying and engaging said first sheet first face carbonless coating.

The references of record relied upon by the examiner are:

McElroy	3,312,005	Apr. 04, 1967
Vermeulen	4,932,684	Jun. 12,

1990

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said to avoid the above problems.

In responding to the examiner's prior art rejections of the herein appealed claims based on McElroy and Kobayashi, appellant indicates that a label and a business form "are not the same thing" (brief, page 11) although labels may be associated with business forms. According to appellant, a label is defined as "the functional portion of a pressure sensitive construction comprising the face sheet and adhesive, die cut into various

shapes." See page 8 of the Glossary of Terms, Tag and Label Manufacturers Institute, copyright 1973. On the other hand, appellant indicates that the term "business form" is "1) any material which has been printed or otherwise especially prepared for the primary purpose of facilitating the entry of variable written information by hand or machine according to some predetermined format. Blank paper may be included, especially if it is continuous and has undergone some manufacturing operation such as punching or perforating to facilitate manual entries, machine writing, or use after

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writing. 2) More specifically, document bearing instructions with repetitive information printed in fixed positions to save writing and reference time." See page 20 of the Business Forms Glossary, published by International Paper Company, copyright 1967, 1977.

THE OBVIOUSNESS REJECTION BASED ON MCLEROY

Appealed claims 1-7 stand rejected under 35 U.S.C. § 103 as obvious over McElroy. Prior to a discussion of the examiner's stated rejection, it should be emphasized that appealed claim 1 defines a business form having a first paper sheet with an associated pressure sensitive adhesive system and a second

substantially transparent water-impermeable plastic sheet associated with a substantially transparent adhesive system that functions to protect the first sheet when applied thereto. As appellant correctly argues, these claimed features are neither described nor suggested by the disclosures in McElroy.

The deficiencies in the examiner's stated rejection based

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on McElroy are readily apparent. Thus, the examiner contends that "[t]he selection of the type of sheets (plastic and water-impermeable, paper stock) used and the type of adhesive (permanent and transparent) would depend on the intended use." See the answer at page 6. But McElroy, a reference which relates to labels only, contains no disclosure related to appellant's "intended use" of a "business form" which includes a second transparent water-impermeable plastic sheet to protect a first paper sheet when the second sheet is applied thereto. We agree with appellant that McElroy does not establish a prima facie case of obviousness for the subject matter defined by rejected claims 1-7. The examiner's rejection is not sustained.

THE OBVIOUSNESS REJECTION BASED ON KOBAYASHI

Appealed claims 1-13 stand rejected under 35 U.S.C. § 103 as obvious over Kobayashi. As with McElroy, the Kobayashi publication similarly fails to establish a prima facie case of obviousness for the subject matter defined by rejected claims 1-13. Although Kobayashi arguably relates to the field of business forms (see column 7, lines 42-45 of Kobayashi which

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describes a "voucher sheet" having blank areas which "the user can freely fill in"), Kobayashi contains no disclosure of a "business form" which includes a second transparent water-impermeable plastic sheet to protect a first paper sheet when the second sheet is applied thereto as required by appealed claim 1. Nor does Kobayashi describe or suggest a "business form" having a first unsegmented paper sheet associated with a second paper sheet having substantially the same size and shape as the first sheet and including a "plurality of lines of weakness separating said second sheet into a plurality of individual labels" as required by appealed claim 8.

Accordingly, the examiner's obviousness rejection based on Kobayashi is not sustained.

THE OBVIOUSNESS REJECTION BASED ON VERMEULEN AND KOBAYASHI

Appealed claims 14-20 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined teachings of Vermeulen and Kobayashi. We do not sustain this rejection. Again, the

examiner has failed to articulate precisely how the disclosures in these references may be combined to arrive at

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the subject matter defined by appealed claims 14-20, much less why one of ordinary skill in this art would have been led or motivated to modify the Vermeulen business form to provide a structure meeting the terms of the rejected claims. See the answer at pages 6 and 7, and compare the brief at page 14.

The decision of the examiner is reversed.

REVERSED

JOHN D. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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